



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/881,096	06/24/1997	GREGORY J. SPEICHER	935-008	2718

7590 12/06/2002

WARD & OLIVO  
708 THIRD AVENUE  
NEW YORK, NY 10017

EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/06/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Applicati n No.

08/881,096

Applicant(s)

SPEICHER, GREGORY J.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears n the c ver sheet with the c rrespondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-14,41-46,48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-14,41-46,48 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 1997 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |



## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 16 October 2002 (Paper No. 16) have been fully considered but they are not persuasive. The arguments are discussed at para. 9 and 10 below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At claim 3 line 10 and claim 9 line 11, "wherein said system initiates" is new matter.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 3-14, 41-46, 48 and 49 are rejected under 35 USC 103(a) as obvious over Hyodo in view of Rondeau.
6. Hyodo teaches (independent claims 3, 9 and 41) a method and apparatus for providing a computer-based advertising system, the method comprising: an advertiser placing an advertisement on said system (col. 4 lines 12-13); storing the advertisement in a database on the system and publishing the advertisement via the Internet (col. 3 lines 13-14 and col. 4



Art Unit: 2162

lines 12-13); wherein said system receives a first connection from a user via the Internet in response to the advertisement (col. 4 lines 12-14).

7. Hyodo does not teach that the first connection is a voice connection. Also, Hyodo does not teach that the system initiates a second voice connection with the advertiser via telephone, and wherein the system couples the first and second connections, enabling a voice connection between the user and advertiser. Rondeau teaches (col. 1 lines 62-65) initiating communication with an advertising computer by telephone, which reads on a first connection that is a voice connection, and Rondeau teaches (col. 3 lines 3-10) that the system initiates a second voice connection with the advertiser via telephone, enabling a voice connection between the user and advertiser. Because the Hyodo service would be enhanced by facilitating users to talk to advertisers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Rondeau to those of Hyodo.
8. Neither of the references explicitly teaches that the system couples said first voice connection with said second voice connection. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Rondeau does teach a first connection that is a voice connection (col. 1 lines 62-65), and Rondeau does teach enabling a voice connection between the user and advertiser (col. 3 lines 1-24), so the two voice connections must be coupled.
9. Applicant argues that there is no suggestion to combine the references (p. 12 *et seq.*). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, The suggestion comes from the well-known business principle that there are times when nothing is better for the buyer than speaking to the advertiser. This is especially so with personal ads. It is for this reason that Hyodo provides a mechanism for the telephone connection (col. 4 lines 12-31).



Art Unit: 2162

10. Applicant argues (p. 12 bottom and p. 15) that Hyodo teaches away from the more sophisticated, automated voice connection mechanism taught by Rondeau. But Hyodo simple teaches a simpler mechanism. One of ordinary skill in the art would readily recognize that the automatic calling from a click-on icon taught by Rondeau is an improvement to simply publishing an 800 number, as taught by Hyodo.
11. Hyodo does not teach (independent claim 41 and dependent claim 48) that the system connects the user with advertiser by executing a sequence of instructions in an advertiser specified order, an iterative number of times, over a predetermined interval until the connection is made. Because it was common, at the time of the invention, for advertisers to have multiple contact numbers (Hyodo lists two at col. 3 lines 29-30), and because it would enhance the service to provide access to more than on of these numbers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide access in an advertiser specified order, an iterative number of times, over a predetermined interval. All of these options were common with electronic communications at the time of the invention, and users would have expected to be provided with this flexibility.
12. Hyodo does not teach (claim 49) the time of a call. As noted in the last paragraph, that sort of flexibility was common and therefore would be expected by users at the time of the instant invention.
13. Neither of the references teaches (claims 4 and 10) maintaining anonymity of the advertiser. This is a well-known property of personals ads.
14. Hyodo also teaches (claims 5, 6, 8, 11, 12, 14, 42 and 46): text advertising, the toll free number, col. 2 lines 34-35, which also reads on an electronic address; telephoning the toll-free number (col. 2 lines 39-40), which reads on audio advertising; and charging the advertiser (col. 4 lines 50-55).
15. Hyodo does not teach (claims 7 and 13) video advertising. Because the reference teaches the WWW, over which video distribution was common at the time of the instant invention, and because video enhances advertising, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add video advertising to the teaching of Hyodo.
16. Hyodo does not teach (claims 43-45) that the contact number is an Internet/LAN/e-mail address. However, the reference does teach the opposite communication, from advertiser



Art Unit: 2162

to user, via the Internet/LAN/e-mail (col. 1 line 28), and because the service would be enhanced by providing as many means for contacting the advertiser as possible, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Internet/LAN/e-mail contact numbers to the teaching of Hyodo.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
20. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, and as a matter of economic necessity, prosecution generally ends with the final rejection. If applicant




Art Unit: 2162

believes that the examiner, Dr. Champagne, has made a grievous error justifying withdrawal of the final rejection, the examiner will consider brief arguments, preferably no more than 25 words. Longer argument is not deemed appropriate after final. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

22. Applicant may have after final arguments considered and amendments entered by filing a CPA or RCE as appropriate. It is the examiner's practice to search the specification of CPA/RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing a CPA or RCE will result in an indication of allowable matter. In this particular case, since applicant has once filed a CPA and examiner has once searched the specification for allowable matter, the prospects are not good that another CPA or RCE could be successful.

23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DLC  
30 November 2002

  
ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600